

REMARKS

In the Office Action,¹ the Examiner rejected claims 1-11 and 17-26 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Published Patent Application No. 2003/0212682 to Nip ("Nip") and U.S. Patent No. 5,940,809 to Musmanno et al. ("Musmanno") in view of U.S. Patent No. 7,363,264 to Doughty et al. ("Doughty").

Claims 1-11 and 17-26 remain pending. Claims 1, 11, and 26 are amended by this reply. No new matter is added.

Applicant respectfully traverses the rejection of claims 1-11 and 17-26 under 35 U.S.C. § 103(a) as being unpatentable over combinations of Nip, Musmanno, and Doughty. A *prima facie* case of obviousness has not been established.

"The key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious." See M.P.E.P. § 2142, 8th Ed., Rev. 7 (July 2008). Such an analysis should be made explicit and cannot be premised upon mere conclusory statements. See id. "A conclusion of obviousness requires that the reference(s) relied upon be enabling in that it put the public in possession of the claimed invention." M.P.E.P. § 2145. Furthermore, "[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art" at the time the invention was made. M.P.E.P. § 2143.01(III), internal citation omitted. Moreover, "[i]n determining the differences between the prior art and the claims, the question under 35 U.S.C. § 103 is not whether the differences

¹ The Office Action may contain a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement or characterization in the Office Action.

themselves would have been obvious, but whether the claimed invention as a whole would have been obvious.” M.P.E.P. § 2141.02(I), internal citations omitted (emphasis in original).

Independent claim 1 recites, among other elements, “storing . . . the output data record having a first data area and a first identification code, the output data record also having a second data area and a second identification code, wherein the first data area is configured to be read by a first of the business applications, and the second data area is configured to be read by a second of the business applications and further wherein the output data record can be read in full or in part by the first and second business applications by referring to the first identification code or the second identification code” (emphases added). The Office Action correctly recognizes that both Nip and Musmanno fail to disclose or suggest the claimed “first data area” and “second data area.” Office Action p. 6. The Office Action does allege, however, that Doughty remedies the deficiencies of Nip and Musmanno. Office Action p. 7. But, these allegations are not correct for at least the following reasons.

In particular, the Office Action alleges that “Nip and Musmanno [are] then modified by Doughty showing two separate data areas accessed by switching software.” Office Action p. 3. The Office Action further alleges that Doughty discloses a “first data area and a second data area.” Applicant respectfully submits that Doughty does not remedy the deficiencies of Nip and Musmanno at least because even if the Patent Office is correct and Doughty does disclose “a first data area and a second data area,” which Applicant does not concede, Doughty does not disclose an “output data

record having a first data area and a first identification code [and] . . . also having a second data area and a second identification code."

Simply stated, Doughty does not disclose or suggest "an output data record" having "a first data area" or having a "second data area." The Patent Office has not shown why one of ordinary skill in the art would be motivated to combine solely a "first data area" or a "second data area," even if such "areas" are taught by Doughty, into an "output data record." Inasmuch as Doughty fails to disclose or suggest an "output data record" having "a first data area" and a "second data area," Doughty does not remedy the deficiencies of Nip and Musmanno. A *prima facie* case of obviousness has not been established with respect to claim 1. For at least this reason, the rejection is improper and should be withdrawn.

Notwithstanding the above discussion, claim 1 is allowable for another separate and distinct reason. For example, claim 1 also recites "**output data record having a first data area and a first identification code [and] . . . also having a second data area and a second identification code."**" More succinctly, no reference provided by the Patent Office discloses or suggests that an "output data record" has a "first identification code" and a "second identification code." Therefore, for at least this reason, Applicant respectfully submits that claim 1 is allowable. Accordingly, Applicant respectfully requests that the rejection be withdrawn.

Independent claims 11 and 26, while of different scope than claim 1, distinguish over Nip, Musmanno, and Doughty for reasons similar to claim 1. Claims 2-10 and 17-25 distinguish over Nip, Musmanno, and Doughty at least due to their dependence from one of the independent claims.

CONCLUSION


In view of the foregoing, Applicant respectfully requests reconsideration and reexamination of this application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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